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EXAMINER

DARNO, PATRICK A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/813,359 | Applicant(s) PFLEGER, KARL | |
| | Examiner PATRICK A. DARNO | Art Unit 2169 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7-9,11-13,38 and 42-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-9,11-13,38 and 42-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. No new claims were added. Claims 3-6, 10, 14-37, and 39-41 are cancelled. Claims 1, 12, 38, 42-49, 52-57, and 59-60 are amended. Claims 1-2, 7-9, 11-13, 38, and 42-60 are pending in this office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2, 11-13, 38, 42-44, 48-52, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,006,225 issued to Dwayne E. Bowman et al. (hereinafter "Bowman") in view of Search Engine Showdown, Google News Loses Functionality, published March 25, 2003 (hereinafter "SES") and further in view of U.S. Patent Number 6,151,624 issued to Keith Teare et al. (hereinafter "Teare").

Claim 1:

Bowman discloses an automated method, comprising:

receiving, by a processor, a search query (*Bowman: column 3, lines 5-9*);

determining, by the processor, whether the received search query includes an entity name

(*Bowman: column 6, lines 5-64*);

determining whether to rewrite the received search query based on information relating to selections of search results from prior searches conducted based on prior search queries

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including the entity name corresponding to a particular entity (*Bowman: column 6, line 59 - column 7, line 34*);

rewriting, by the processor, the received search query when the information relating to selections of search results from the prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name (*Bowman: column 6, line 59 - column 7, line 34*);

performing, by the processor, a search based on one of the received search query and the rewritten search query to obtain search results (*Bowman: Figure 9*); and

outputting, by the processor, the list of search results for presentation on a display (*Bowman: Figure 9, element 920 and column 14, lines 13-18*).

Bowman teaches the step of “performing, by the processor, a search based on one of the received search query and the rewritten search query to obtain search results (*Bowman: Figure 9*);” by providing hyperlinks to the rewritten search queries, in contrast the claimed invention performs this step automatically. However, MPEP 2144.04 states, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined “old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.” The court held that broadly providing an

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automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Bowman does not explicitly disclose wherein the rewrite includes a restrict identifier associated with an entity. However, SES teaches restricting searches to a domain or site of a news source using a restrict identifier, and Teare discloses resolving an entity name to a corresponding URL based on statistics from prior queries (*Teare: column 21, lines 39-67*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of SES and Teare to allow the user to narrow the search results and to aid in providing the desired web page. This combination would yield the predictable results wherein a query is restricted to a domain and the domain is resolved from an entity name based on prior queries.

Claim 2:

The combination of Bowman, SES, and Teare discloses all the elements of claim 1, as noted above, and Bowman further discloses providing a link to the received search query, where selection of the link causes a search to be performed based on the received search query (*Bowman: Fig. 9, element 910*).

Claim 11

The combination of Bowman, SES, and Teare discloses all the elements of claim 1, as noted above, and Bowman further discloses where performing a search based on one of the received search query and the rewritten search query comprises: searching a repository of documents using the rewritten search query when the received search query is rewritten (*Bowman: column 5, lines 11-25 and column 1, lines 44-46*).

Claim 12:

Claim 12 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 13:

Claim 13 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 38:

Claim 38 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 42:

Claim 42 is rejected under the same reasons set forth in the rejection of claim 1 and further in view of Teare: column 7 which teaches searching for a store name and mapping it to the appropriate domain.

Claim 43:

Claim 43 is rejected under the same reasons set forth in the rejection of claim 1. Also, note that SES shows that it is desirable to restrict to a domain for a given source name.

Claim 44:

Claim 44 is rejected under the same or similar reasons as those set forth in the rejection of claim 2.

Claim 48:

Claim 48 is rejected under the same reasons set forth in the rejection of claim 1.

Claim 49:

Claim 49 is rejected under the same reasons set forth in the rejection of claim 1, and further in view of Bowman: column 4, lines 36-44 which discloses that the search is being performed to retrieve for documents.

Claim 50:

Claim 50 is rejected under the same reasons set forth in the rejection of claim 43.

Claim 51:

Claim 51 is rejected under the same reasons set forth in the rejection of claim 1 and 43.

Claim 52:

Claim 52 is rejected under the same or similar reasons set forth in the rejection of claims 1, 12, 13, and 38.

Claim 59:

Claim 59 is rejected under the same reasons set forth in the rejection of claim 2.

3. Claims 7-9, 45-47, 53-58, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowman in view of SES in view of Teare and further in view of U.S. Patent Number 6,564,210 issued to Nahum Korda et al. (hereinafter “Korda”).

Claims 7 and 45:

The combination of Bowman, SES, and Teare discloses all the elements of claim 1 and 13, as noted above, but the previously mentioned combination fails to explicitly disclose all the limitations of claims 7 and 45.

However, all the limitations of claims 7 and 45 would have been obvious to one of ordinary skill in the art at the time the invention was made when the previously mentioned combination is taken in view Korda. First applicant claims “identifying entity identifiers associated with documents that were selected in connection with the prior searches involving the

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entity name”. Korda: column 8, lines 44-59 discloses storing data on documents selected by a user after a search, this data including the URL of the document which is an entity identifier as well as the topic which is also an entity identifier, Bowman teaches the search including an entity name or being an entity name.

Furthermore, Korda discloses:

determining a total number of selections for each of the identified entity identifiers,

(Korda: column 9, lines 14-19 and column 9, lines 20-25), and

and determining that the received search query should be rewritten when an entity identifier associated with the entity name receives a total number of selections greater than other ones of the identified entity identifiers *(Korda: column 9 lines 14-25 teaches using the identifiers to narrow the search results, and Bowman column 6, lines 32-49 teaches making restrictions based on frequency).*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Korda noted above. Therefore, the limitations of claims 7 and 45 would have been obvious to one of ordinary skill in the art at the time of the invention as one would have been motivated to provide the teachings of Korda to increase the productivity of the user *(Korda: column 2, lines 8-14).*

Claims 8 and 46:

The combination of Bowman, SES, Teare, and Korda discloses all the elements of claims 7 and 45, as noted above, and the limitations of claim 8 would have been obvious in view of Korda, as Korda further discloses:

determining whether the total number of selections for the entity identifier associated with the entity name is greater than a threshold *(Korda Col 9 lines 14-19), and*

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determining that the received search query should not be rewritten when the total number of selections for the entity identifier associated with the entity name is not greater than the threshold (*Korda: Teaches not further restricting the results until the threshold is met in Col 9 lines 14-19*).

Claims 9 and 47:

The combination of Bowman, SES, and Teare discloses all the elements of claim 1 and 13, as noted above, but the previously mentioned combination fails to explicitly disclose all the limitations of claims 9 and 47.

However, all the limitations of claims 9 and 47 would have been obvious to one of ordinary skill in the art at the time the invention was made when the previously mentioned combination is taken in view Korda. First applicant claims, “means for identifying entity identifiers associated with documents that were selected in connection with the prior searches involving the entity name”. Korda: column 8, lines 44-59 discloses storing data on documents selected by a user after a search, this data including the URL of the document which is an entity identifier as well as the topic which is also an entity identifier, Bowman teaches the search including an entity name or being an entity name.

Furthermore, Korda discloses: means for identifying a distribution of a total number of selections for each of the identified entity identifiers, and means for rewriting the received search query when the distribution indicates that the total number of selections, for an entity identifier associated with the entity name is peaked compared to the total number of selections for a subset of other ones of the identified entity identifiers. (*These limitations would have been obvious as Korda*

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teaches counting the number of selections as shown above and Bowman teaches making the selection of further restriction based on frequency and ordered based on frequency in col 6 lines 32-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Korda noted above. Therefore, the limitations of claims 7 and 45 would have been obvious to one of ordinary skill in the art at the time of the invention as one would have been motivated to provide the teachings of Korda to increase the productivity of the user (*Korda: column 2, lines 8-14*).

Claims 53 and 55:

Claims 53 and 55 are rejected under the same reasons set forth in the rejection of claims 7 and 45.

Claim 54:

Claim 54 is rejected under the same reasons set forth in the rejection of claims 9 and 47.

Claim 56:

Claim 56 is rejected under the same reasons set forth in the rejection of claims 8 and 46.

Claim 57:

Claim 57 is rejected under the same reasons set forth in the rejection of claims 7, 42, and 45.

Claim 58:

Claim 58 is rejected under the same reasons set forth in the rejection of claims 8 and 42.

Claim 60:

Claim 60 is rejected under the same reasons set forth in the rejection of claims 7, 43, and 45.

Response to Arguments

Examiner Notes

Many of the arguments submitted below, were previously submitted in an RCE filed by the Applicant and received 04/25/2008. The Examiner thoroughly responded to each one of the arguments in the office action mailed 08/22/2008. Applicant's act of submitting substantially the same arguments again in a response received 11/24/2008, without any substantial claim amendments, has failed to persuade the Examiner. Where appropriate, large portions of the Examiner's prior office action mailed 08/22/2008 action may be regurgitated because the arguments presented remain substantially the same. Simply put, the Applicant and the Examiner disagree about the appropriateness of the prior art rejections given in the preceding office action. In order to move prosecution along, the Examiner suggests amending the claims to overcome the prior art of record, or if Applicant deems necessary, filing a pre-appeal brief or appeal brief in order to move into the next face of prosecution such that a 3rd party could resolve the disagreement between the Applicant and Examiner.

Argument #1:

Applicant Argues:

Bowman et al., SES, and Teare et al., whether taken alone or in any reasonable combination, do not disclose or suggest the combination of features recited in claim 1. For example, Bowman et al., SES, and Teare et al. do not disclose or suggest rewriting, by a processor, a received search query to include a restrict identifier relating to a domain associated with a particular entity when information relating to selections of search results from prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name, as recited in claim 1.

Examiner Responds:

Examiner is not persuaded. First, it is noted that the rejection of claim 1 is not a rejected under 35 U.S.C. 102. The limitations argued above were rejected as being obvious in view of the combination of Bowman, SES, and Teare. This means that the combination, when taken as a whole, renders the claim limitation an obvious variation of the claimed combination.

While stating such, it appears to be clear that Bowman discloses rewriting, by a processor, a received search query when information relating to selections of search results from prior searches indicates that users intend a particular entity when the users submitted the prior searches including the entity name [Bowman: column 6, line 59 - column 7, line 34].

Specifically note that the cited passage of Bowman discloses invoking a "related term selection process." These related terms are discovered based upon queries which previously ran successfully, which appears to be equivalent to the Applicant's claimed "information relating to selections of search results from prior searches" [Bowman: column 7, lines 4-10 and column 7, lines 14-17]. And finally note that the suggested query terms are "resented to the user in Fig. 9. These terms are suggested to the user because they may be further narrow than the search results presented to a user. By further limiting, refining, or restricting the query, for the purpose of reducing the number of search results, the user is better able to find exactly what he/she intended to find.

This related terms returned to the user in Bowman clearly suggest terms that the user can use to modify, or rewrite a query. However, this process of "rewriting" the query is done manually by the user selecting the terms from the recommended list in order to generate a new query. This is where In re Venner comes in. In re Venner provides motivation stating that it is

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obvious to one of ordinary skill in the art to automate a known manual process. Since Bowman discloses the manual steps needed to carry out a rewrite of a query using suggested terms, then it would have been obvious to one of ordinary skill in the art to automate such known manual processes [In re Venner].

Finally, it is noted that SES suggests modifying or rewriting a query to include a restrict identifier. See rejection of claim 1 and the SES print-out sent with prior office actions.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #2:

Applicant Argues:

At column 6, lines 59 – column 7, line 34, Bowman et al. discloses storing a related term together with a correlation score that indicates the number of times the related term has appeared in combination with a key term in the user queries. Bowman et al also discloses that when a user submits a query, one or more related terms are identified and these related terms are presented as suggested terms with the query result listing. Nowhere in this section, or elsewhere, does Bowman et al. disclose or suggest anything that can reasonably correspond to information relating to selections of search results from prior searches.

In response to a similar argument previously presented by Applicant, the Examiner alleged:

Note that the cited passage of Bowman discloses invoking a "related term selection process." These related terms are discovered based upon queries which were previously ran successfully, which **appears to be equivalent** to the Applicant's claimed "information relating to selections of search results from prior search queries" [Bowman: column 7, lines 4-10 and column 7, lines 14-17.]

(Office Action, page 10)(emphasis added). It is unclear from the Examiner's allegations whether the Examiner is (1) alleging that entering multiple terms of a user query corresponding to selecting results, or (2) alleging that because the selection process in Bowman et al. is "based upon queries which were previously ran successfully" that this somehow corresponds to information relating to selections of search results. In either case, Applicant submits that the Examiner's allegation lacks merit.

Examiner Responds:

Examiner is not persuaded. The suggested search terms are returned to a user based upon the highest correlation scores [Bowman: column 7, lines 14-23]. And correlation scores depend whether or not that a query, or query term, has been "successful" in the past query runs [Bowman: column 7, lines 4-13]. For a query, or query term, to have been "successful" means that it must have at least "corresponded to" or been "associated with" search results deemed helpful by a user in the past. Therefore, it appears that the related terms do at least "reasonably correspond" to information relating to selections of search results from prior searches.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #3:

Applicant Argues:

The Examiner admitted that Bowman et al. does not disclose rewriting a received search query to include a restrict identifier (Office Action, page 4). The Examiner alleged that SES discloses restricting searches to a domain or site of a news source using a restrict identifier (Office Action, page 4). the Examiner alleged that it would have been obvious to include a restrict identifier in Bowman et al. "to allow the user to narrow the search results and to aid in providing the desired web page" (Office Action, page 4). Applicant submits that the Examiner's allegation lacks merit

The Examiner has not explained how the Bowman et al. system would benefit from including a restrict identifier relating to a domain associated with a particular entity.

Examiner Responds:

Examiner is not persuaded. It is not a requirement that a combination of reference under 35 U.S.C. 103(a) must be shown to achieve a benefit of such combination. According to the U.S. Supreme Court, all that is required is that when the references are combined, result of

such combination would have been predictable [KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385, 1395 (2007) and MPEP 2141, Section I “The KSR Decision and Principles of the Law of Obviousness”].

The Examiner asserts that the combination of Bowman, SES, and Teare would set forth the predictable results of a query being restricted to a domain wherein the domain is resolved from an entity name based on prior queries.

Since the combination of references would yield a predictable result, the combination of references appears to be proper under 35 U.S.C. 103(a).

Argument #4:

Applicant Argues:

In response to a similar argument previously presented by Applicant, the Examiner alleged:

The embodiment cited by the Applicant in Bowman: column 4, lines 58-67 appears to be directed to only a single domain (i.e., the Amazon.com web site). However, Bowman: column 4, lines 35-40 lists other implementations of the Bowman invention. An alternative implementation states that the search refinement methods of the Bowman invention could be implemented as an on-line services network. Surely an “on-line services network” comprises a plurality of two or more domains.

In such an embodiment, as suggested by Bowman, a search such as that disclosed by the “source” command disclosed by SES for limiting a search to particular domain would indeed be useful. Furthermore, the results would be predictable.

(Office Action, page 12)(emphasis in original). It appears from the Examiner's choice of language, that the Examiner is alleging that two or more domains are inherent to an on-line services network. Applicant disagrees. This conclusion appears to be based solely on impermissible hindsight.

Examiner Responds:

Examiner is not persuaded. The Examiner did not make an inherency rejection. The text of Bowman is clear. Bowman contains multiple embodiments. There is at least one embodiment which appears to be directed to only a single domain (i.e., the Amazon.com web

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site) [Bowman: column 4, lines 58-67]. However, there is at least one embodiment that expressly suggests that two or more domains are searched. Note specifically that Bowman discloses wherein his invention is part of an "on-line services network." [Bowman: column 4, lines 35-40]. In such an embodiment, as suggested by Bowman, a search such as that disclosed by the "source" command disclosed by SES for limiting a search to a particular domain would indeed be useful. Furthermore, the results would be predictable.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #5:**Applicant Argues:**

According to M.P.E.P. § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

Examiner Responds:

Examiner is not persuaded. No argument of inherency has been asserted. Bowman: column 4, lines 36-44 clearly discloses wherein the invention of Bowman is used on a single website [or domain] **and/or** wherein the invention of Bowman is used on a plurality of websites [or domains] such as an on-line services **network**. Here there is clear contrast between implementation of the invention on a single website and implementation on an entire **network** comprising many sites. As such, all claim limitations have been either disclosed or suggested by the prior art of record. And no inherency argument has been made.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #6:

Applicant Argues:

Teare et al. does not disclose or suggest anything that would cure the deficiencies in the disclosures of Bowman et al. and SES that are identified above. Thus, Bowman et al., SES, and Teare et al., whether taken alone or in any reasonable combination, do not disclose or suggest rewriting, by a processor, a received search query to include a restrict identifier relating to a domain associated with a particular entity when information relating to selections of search results from prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name, as recited in claim 1.

The Examiner still has not explained what feature(s) of claim 1 Teare et al. allegedly discloses. Rather, the Examiner merely quotes and/or cites to certain portions of Teare et al. that allegedly disclose resolving real names into network addresses. Claim 1 does not recite resolving real names into network addresses. Regardless of whether Teare et al. discloses resolving real names into network addresses, Teare et al. does not cure the deficiencies in the disclosure of Bowman et al. and SES identified above. Thus, Bowman et al., SES, and Teare et al., whether alone or in any reasonable combination, do not disclose or suggest rewriting, by a processor, a received search query to include a restrict identifier relating to a domain associated with a particular entity when information relating to selection of search results from prior searches indicates that users intended the particular entity when the users submitted the prior search queries including the entity name, as recited in claim 1.

Examiner Responds:

Examiner is not persuaded. The Teare reference is cited as disclosing "resolving an entity name on statistics from prior queries [Teare: column 21, lines 20-24 and column 21, lines 39-67].

This rejection is based upon the very narrow interpretation of the claim limitation rewriting the received search query to include a restrict identifier relating to the domain associated with the particular entity. This limitation appears to be the equivalent of resolving an entity name to a corresponding URL based upon statistics of prior queries. This interpretation set forth by the Examiner is supported in the Applicant's Published Specification Number 2005/0222976 paragraph [0054]. While Bowman and SES do not expressly recite "resolving an entity name on

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statistics from prior queries", Teare is cited in order to get to the heart of Applicant's invention, as discussed in at least paragraph [0054] of the Applicant's published specification. As a result, the combination of Bowman, SES, and Teare appears to disclose the Applicant's claimed invention.

Since it appears the each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #7:

Applicant Argues:

Bowman et al., SES, and Teare et al. also do not disclose or suggest automatically performing, by a processor, a search restricted to the domain associated with the particular entity, based on the rewritten search query, to generate a list of search results, as further recited in claim 1.

Claim 1 does not simply recite automating a manual activity. In other words, performing a search is not a manual activity. It is an automated activity, which is being automatically performed in claim 1. In other words, claim 1 recites that a search is automatically performed (i.e., a search is performed without requiring the user to select a link to perform the search). By automatically performing the search as recited in claim 1, a user can be presented with useful search results faster than, for example, a system that requires the user to select a link to perform a search. Thus, the Examiner is misapplying the prior legal decision.

Examiner Responds:

Examiner is not persuaded. The Examiner did assert that Applicant's claim 1 assert a manual activity. The Examiner asserted that the Bowman reference performs the same function as the Applicant's claimed invention, with respect to one minor aspect. That aspect is the "manual" rewriting, or modifying of a query. As a result of this deficiency, the Examiner set forth that it is obvious to one of ordinary skill in the art at the time the invention was made to automate the manual steps set forth by Bowman. The Examiner's assertion is backed up case law with the ruling in In re Venner. The Application of holding in Venner was appropriate. For even

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further analysis, see Response to Arguments in the Examiner's non-final rejection mailed 08/22/2008.

As a result, it appears that the Applicant's claimed invention is simply an obvious variation of the prior art of record. Therefore, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #8:

Applicant Argues:

Nowhere in connection with Figure 9, or elsewhere, does Bowman et al. disclose or suggest providing a link to a received search query with search results obtained from a search performed on a domain associated with a particular entity, where selection of the link causes a search to be performed based on the received search query as recited in claim 2. SES and Teare et al. also does not disclose or suggest this feature of claim 2.

Examiner Responds:

Examiner is not persuaded. The Bowman reference clearly discloses "providing a link to the received search query, where selection of the link causes a search to be performed based on the search query" [Bowman: Fig. 9, element 910], as recited in claim 2.

Specifically, Fig. 9 even includes a caption by the title "Related Query Terms" which recites "**Click the link below to narrow your search by adding a related term**". Upon clicking this link, a search is performed. The reference on this issue is so clear, that further explanation is not required.

Since it appears that each and every element of the Applicant's claimed invention is either disclosed or suggested by the prior art of record, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #9:

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Applicant Argues:

SES does not disclose or suggest that it is “desirable” (Examiner’s wording) to restrict to a domain for a given source name, as alleged by the Examiner. Instead, SES discloses that it is possible to restrict a search to a particular news source in Google News. Nowhere does SES disclose or remotely suggest restricting a search to a domain associated with a particular store associated with a store name included in a received search query.

Examiner Responds:

Examiner is not persuaded. The Applicant argues that SES fails to disclose or suggest that it would “desirable” to restrict a domain to a specific source name. However, the Examiner is unaware of any requirement under 35 U.S.C. 103(a) which requires showing how a system will benefit from combining features from multiple references. Instead the rulings of the courts, as noted above, appear to be directed to whether or not the results of a combination of references would be predictable. Specifically, the U.S. Supreme Court has required that when references are combined for a rejection under 35 U.S.C. 103(a), result of such combination would have been predictable [*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007) and MPEP 2141, Section I “The KSR Decision and Principles of the Law of Obviousness”].

The Examiner asserts that the combination of Bowman, SES, and Teare would set forth the predictable results of a query being restricted to a domain wherein the domain is resolved from an entity name based on prior queries.

With respect to the rejections of claims 43 and 50, it is clear that SES discloses restricting a given search query to a domain for a given source name [specifically, source: new_york_times]. The Examiner sets forth that this source name can come from any entity that has a URL. It can be a particular web site URL, a news source [as explicitly shown in SES], or a store name found in the URL of an online shopping web site. It follows then that claims 43 and 50 are rejected under

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similar reasons since the "source name" used with the source operator disclosed by SES could be a new source, or some other entity like the name of a store found in a source title for a store posting an on-line shopping web site [see SES "Instead of site: try using source: which should be followed by either the single word for the source title that Google shows in green..."]. Finally, it is also noted that Teare discloses searching for a store name and mapping it to an appropriate domain [Teare: column 7].

Since it appears that the Applicant's claimed invention is simply an obvious variation of the combination of Bowman, SES, and Teare, the claims remain rejected under the reasons set forth in the preceding office action.

Argument #10:**Applicant Argues:**

Bowman et al., SES, and Teare et al., whether taken alone or in any reasonable combination, also do not disclose or suggest means for automatically performing a search restricted to the domain associated with the particular entity, based on the rewritten search query, to obtain search results in lieu of performing a search based on the received search query, as further recited in claim 12.

The Examiner did not address this feature, but instead, generally referred to the rejection of claim 1 (Office Action, page 4). Claim 1, however does not recite this feature. Therefore, the Examiner did not establish a prima facie case of obviousness with regard to claim 12. [emphasis in original]

Examiner Responds:

Examiner is not persuaded. The Examiner did not fail to address any feature of the claimed limitation. The Examiner simply stated that Claim 12 is rejected under the same reasons as claim 1. In effect, the Examiner is saying that the same portion of the references that discloses rewriting, by a processor, a received search query when information relating to selections of search results from prior searches indicates that users intend a particular entity when the users submitted the prior searches including the entity name" **also discloses** "for

automatically performing a search restricted to the domain associated with the particular entity, based on the rewritten search query, to obtain search results in lieu of performing a search based on the received search query". The Examiner will not regurgitate his office action here.

However, it does not appear that the Applicant has shown why the prior art fails to teach this limitation. Further, it appears that the Applicant is arguing that claim 12 is patentably different from claim 1. While the Examiner disagrees, the Applicant's argument is reasonable. But if the Applicant wants to maintain this argument, that the invention of claim 1 and the invention of claim 12 are separate and distinct inventions, then the next office action mailed by the Examiner will be an election restriction requirement wherein the Applicant can choose between the invention of claim 1, and its sibling claims, and invention of claim 12 and its sibling claims. So, if the Applicant does in fact feel that they are patentably distinct, please contact the Examiner to elect one of the groups.

The claims remain rejected under reasons set forth in the preceding office action.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. DARNO whose telephone number is (571)272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on (571) 272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick A. Darno/
Examiner
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03-02-2009

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/Mohammad Ali/

Supervisory Patent Examiner, Art Unit 2169